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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,141	08/22/2000	Stephen F. Gross	M 6636 CC/CSAP	8795

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COGNIS CORPORATION
2500 RENAISSANCE BLVD., SUITE 200
GULPH MILLS, PA 19406

EXAMINER

CARRILLO, BIBI SHARIDAN

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 01/13/2003

1/

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/643,141

Applicant(s)

GROSS ET AL.

Examiner

Sharidan Carrillo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-50, 53 and 54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-50, 53-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 46 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 46 is indefinite because it is unclear what is meant by a “thermal stability”. Further, does the thermal stability refer to all of the components of the composition or specific components (i.e. alkyl ester) of the composition.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 33-34, 36-42, and 44-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Stevens (6172031).

Stevens teaches a method of cleaning hard surfaces using applicant’s claimed cleaning composition.

In reference to claim 33, refer to col. 14, lines 1-5, col. 12, lines 45-50.. In reference to

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components a) and b) refer to col. 4, lines 40-45, col. 3, lines 20-22; component c) refer to col. 3, lines 18-20, col. 6, lines 23-55; component d) refer to col. 3, lines 40-45, col. 10, lines 15-20 and lines 30-55; and component e) refer to col. 3, line 23.

In reference to claim 34, refer to col. 8, lines 10 and 23. In reference to claims 36, refer to col. 3, lines 18-20. In reference to claim 37, refer to col. 8, lines 8-10. In reference to claim 38, the limitations are met since Stevens teaches sulfates of dodecylbenzenesulfonic acid. In reference to claim 39, refer to col. 3, lines 18-20. In reference to claim 40, refer to col. 6, lines 30-40. In reference to claim 41, refer to col. 3, lines 15-17. In reference to claim 42, refer to col. 3, lines 40-45. In reference to claim 44, refer to col. 10, lines 18-20. In reference to claim 45, refer to col. 13, line 20. In reference to claim 46, refer to col. 4, lines 50-55. In reference to claims 47-48, refer to col. 3, lines 15-25.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 35 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens (6172031).

Stevens teaches the invention substantially as claimed. Stevens fails to specifically teach an isopropyl amine salt of dodecylbenzenesulfonic acid or propylene glycol n-butyl ether. However, in col. 8, lines 23-25, Stevens teaches alkyl amine dodecylbenzenesulfonate. It would have been within the level of one of ordinary skill in the art to have modified the method of Stevens to include isopropyl amine salt of dodecylbenzene sulfonic acid since Stevens teaches that alkyl amines can be used and isopropyl amine is an alkyl amine.

Stevens fails to specifically teach propylene glycol n-butyl ether. However, in col. 10, lines 31-60, Stevens teaches that glycol ethers for use include without limitations propylene glycol substituted ethers. Some of the examples recited n-butyl ether. It would have been within the level of one of ordinary skill in the art to have modified the method of Stevens to include propylene glycol n-butyl ether since Stevens teaches that propylene glycol substituted ethers could be used.

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9. Claims 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens (6172031) as applied to claims 33-34, 36-42, and 44-48 as described in paragraph 4 above, and further in view of Van Eenam (5585341).

Stevens teaches the invention substantially as claimed with the exception of cyclic ketone, specifically cyclohexanone. Van Eenam teaches that a hard surface cleaner/degreaser commonly incorporate organic solvents such as cyclohexanone (col. 3, lines 35-40, col. 4, lines 14-15, lines 44-45) in their cleaning compositions.

It would have been within the level of one of ordinary skill in the art to incorporate commonly known organic solvents in the cleaning composition, such as cyclohexanone, as taught by Van Eenam, for purposes of cleaning and or degreasing hard surfaces.

10. Claims 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens (6172031) as applied to claims 33-34, 36-42, and 44-48 as described in paragraph 4 above, and further in view of Cilley et al. (6180583).

Stevens teaches the invention substantially as claimed with the exception a thickening agent such as tetraalkyl ammonium bentonite (equivalently known as bentonite). It well known in the art to include additional components such as thickeners in cleaning compositions. Cilley et al. teach cleaning compositions for cleaning hard surfaces and removing greasing comprising thickeners. In col. 6, line 12-15, and line 35, Cilley et al. teach adding a thickener in the composition to promote adhesion of the composition to the surface being cleansed. Commonly known thickeners include bentonite.

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It would have been obvious to a person of ordinary skill in the art to have modified the method of Stevens to include adding a thickener, such as bentonite, as taught by Cilley et al., for purposes to promoting adhesion of the composition to the surface being cleansed.

Response to Arguments

11. The rejection of claim 46 under 112, second paragraph is maintained since the specification also fails to define thermal stability. Applicant's arguments are unpersuasive since applicant has also not defined what the term "thermal stability" means.

12. Applicant argues that the claims are not anticipated by Stevens because although Stevens suggests "terpene-free", the reference fails to mandate its absence. Applicant further argues that the oil-soluble surfactant, as taught by Stevens, is optional and not mandatory in the cleaning composition. Applicant's arguments are not persuasive because applicant is relying on preferred embodiments and not on the teachings of the reference as a whole. The broad disclosure of a reference is relevant prior art for all it would have suggested to those of ordinary skill. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. Disclosed examples and preferred examples do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 169 UPQ 423 (CCPA 1971). Clearly, one possible composition would include a terpene free composition having an oil soluble surfactant.

13. Applicant further argues that Stevens fails to teach the amount of the oil-soluble anionic surfactant and the water-soluble anionic surfactant. Applicant argues that the teachings of Stevens is not analogous to the claimed range for each specific surfactant. Applicant has not provided reasoning to support the argument of nonanalogous. Further, Stevens specifically

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teaches one or more surfactants, wherein the amount of surfactant ranges from 0.001-25 percent, the claimed range falling with the range taught by the prior art reference.

14. Applicant further argues that the short-chain cosurfactant of the instant invention is not anticipated by Stevens because Stevens teaches the short-chain cosurfactant for use in a rinse and not a cleaning composition. Applicant is directed to col. 22, lines 5-7 which teaches the glycol ether for use in a cleaning and degreasing composition.

15. Applicant argues that it would not have been obvious to modify the reference of Stevens to include isopropyl amine salt of dodecylbenzene sulfonic acid. Applicant's arguments are unpersuasive since Stevens teaches the genus alkyl amine dodecylbenzenesulfonate and isopropyl amine is a species of the genus taught by Stevens. One of ordinary skill in the art would have envisaged isopropyl amine as a member of the genus alkylamine dodecylbenzene sulfonate. In reference to claim 43, similar arguments apply. Also refer to col. 10, lines 39-56.

16. In reference to claims 49-50 and 53-54, arguments have been previously addressed, as discussed above.

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharidan Carrillo whose telephone number is 703-308-1876.

The examiner can normally be reached on Monday-Friday, 6:00a.m-2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on 703-308-4333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7719 for regular communications and 703-305-7719 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Sharidan Carrillo
Primary Examiner
Art Unit 1746



**SHARIDAN CARRILLO
PRIMARY EXAMINER**

bsc
January 9, 2003